

REMARKS

The final Office Action dated June 26, 2008 has been received and its contents carefully noted. Claims 46-96 remain pending in the application. The specification has been amended. No new subject matter has been added. In view of the actions above and the following remarks, reconsideration of this application is now respectfully requested.

Specification

The specification is objected to as failing to provide antecedent basis for the claimed subject matter. Specifically, the Office Action asserts that “[t]he phrase ‘storage device’ is not found to have proper antecedent basis in the specification.” (Office Action, page 3, lines 4-5.) In view of the amendment to the specification, Applicants respectfully submit that the objection has been overcome. In particular, the specification has been amended to state that “[e]mbodiments include a program product comprising a storage device containing instructions operable on a computer for automated generation of aggregate creatives, the instructions operable with the computer to perform the processes of the present invention.” (emphasis added.) Support for this amendment can be found, for example, in originally filed claim 16, which recites “[a] program product comprising a storage device containing instructions operable on a computer for automated generation of aggregate creatives, the instructions operable with the computer to perform the steps of” According to the MPEP, “[t]he claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter.” MPEP §2163.06 I (citing *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985)). Therefore, the specification has been properly amended to provide sufficient antecedent basis for the claimed subject matter, and as a result, withdrawal of the objection is in order and is respectfully requested.

Claim Rejections under 35 U.S.C. § 101

Claims 63-96 are rejected under 35 U.S.C. § 101 because the Office Action asserts that the claimed invention is directed to non-statutory subject matter. According to the Office Action, “[c]laims 63-79 disclose a system; however, the claims and [sic] fail to disclose if this system indicate any hardware since The use of the word ‘system’ does not inherently mean that claim is directed to a physical machine.” (Office Action, p. 4, lines 36-38.)

Applicants respectfully traverse the rejection, because contrary to the assertion in the Office Action, claims 63-79 recite sufficient structure in the form of means-plus-function elements to carry out aspects of the present invention and to be statutory.

Claims 63-79 are directed to a system comprising elements written in means plus function format according to 35 U.S.C. § 112, paragraph 6. As MPEP § 2106 II.C. explains, “[w]here means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and ‘equivalents thereof’ that correspond to the recited function.” Therefore, the structures corresponding to the elements written in means plus function format can be found in the present specification. For example, referring to FIG. 1, the present specification as amended now explains:

Server-side system 22 includes an advertising system processor 26 connected to an advertising system processor 26 connected to an advertising database 28, and a user interface 30. . . . Advertising system processor 26 comprises any conventional computer, for example a personal computer, server or mainframe, capable of performing the functions described below. Similarly, advertising database 28 comprises any conventional storage system for storing the data described below as well as software for performing the processes of the present invention. Embodiments include a program product comprising a storage device containing instructions operable on a computer for automated generation of aggregate creatives, the instructions operable with the computer to perform the processes of the present invention.

(Present specification as amended, p. 9, starting at line 16, emphases added.) Accordingly, the structure in the present specification for the means recited in claims 63-79 includes “any conventional computer” connected to “any conventional storage system . . . storing . . . software” which is accessed and performed by the conventional computer. In addition, the structure also includes “a program product comprising a storage device containing instructions operable on a computer.” According to MPEP § 2105, “a claimed computer-readable medium encoded with a computer program” is statutory. The “storage system” and the “storage device” described in the present specification clearly corresponds with the “claimed computer-readable medium” described by MPEP § 2105.

The “storage system” and “storage device” described in the specification clearly include hardware based at least on their ability to act as a medium on which instructions can be stored and accessed by computer hardware and their ability to act with the computer hardware to cause the instructions to be physically realized. Moreover, the specification

indicates that the storage device includes hardware when it explains that the storage device is a part of “a program product.” According to the MPEP, “[p]roduct claims are claims that are directed to either machines, manufactures or compositions of matter.” MPEP § 2106 I. C. (emphases added.) Indeed, the MPEP associates a claimed product with physical structure in the present context when it states: “When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.” MPEP § 2106.01 I. (emphasis added). Accordingly, claims 63-79 are statutory, because the structure of the “storage system” and “storage device” in the specification is incorporated into the means plus function language of the claims according to 35 U.S.C. § 112, paragraph 6.

The Office Action also asserts that “[c]laims 80-96 disclose a storage device; however, the claims and the specification fail to disclose if this storage device indicates any hardware therefore the storage device representing [sic] a data structure.” (Office Action, p. 4, lines 39-41.) Claims 80-96 expressly claim a “program product comprising a storage device containing instructions operable on a computer for the automated generation and serving of aggregate creatives, the instructions operable with the computer to perform the steps of . . .” As described above, according to the MPEP, “[p]roduct claims are claims that are directed to either machines, manufactures or compositions of matter.” MPEP § 2106 I. C. (emphases added.) In addition, the “storage device” described in the specification clearly includes hardware based at least on its ability to act as a medium on which instructions can be stored and accessed by computer hardware and its ability to act with the computer hardware to cause the instructions to be physically realized. (See present specification as amended, p. 9, starting at line 16.) Thus, the “storage device” recited by claims 80-96 sufficiently indicate hardware so that the claims do not recite computer programs per se.

In view of the structure, e.g., a program product comprising a storage device, clearly claimed in claims 63-96, Applicants respectfully submit that claims 63-96 are statutory. Withdrawal of the rejection under 35 U.S.C. § 101 is in order and is respectfully requested.

Claim Rejections under 35 U.S.C. § 103

Claims 46, 49-55, 58-63, 66-72, 75-80, 83-89, and 92-96 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2002/0036654 to Evans et al. (Evans) in further view of U.S. Pat. App. Pub. No. 2005/0027594 to Yasnovsky et al. (Yasnovsky). Claims 47-48, 56, 64-65, 73, 81-82, and 90 are rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Evans in further view of Yasnovsky, and in further view of U.S. Pat. App. No. 2002/0147645 to Alao et al. Claims 57, 74, and 91 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans, in further view of Yasnovsky, and in further view of U.S. Pat. App. No. 2003/0191693 to Aphek.

Applicant is submitting herewith the Declarations of joint inventors Brett Alan Gorsline and Ron Hyman Rothman in accordance with 37 C.F.R. § 1.131. The 1.131 Declarations are being offered to swear behind the Yasnovsky reference. Yasnovsky was filed on November 3, 2003 and claims priority to U.S. Provisional Application No. 60/490,741, which was filed on July 28, 2003. The filing date of the present application is less than five (5) months after the filing date of U.S. Provisional Application No. 60/490,741. Yasnovsky does not qualify as prior art under 35 U.S.C. § 103(a) because Applicant's invention date precedes the earliest priority date of Yasnovsky, i.e., July 28, 2003. As such, Applicant traverses the rejections of claims 49-96 as they all apply Yasnovsky as a basis for rejection. Applicant, however, does not concede that the citations by the Office Action in support of the claim rejections are actually supported by Yasnovsky. Withdrawal of the rejections are in order and is respectfully requested.

In light of the amendment to the specification and the remarks provided hereinabove, Applicants respectfully submit that the present application is now in condition for allowance. However, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicants' representative, then the Examiner is invited to contact the undersigned by telephone in order that further prosecution of this application can thereby be expedited.

Respectfully submitted,

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